

REMARKS

I. Status of the Claims

Claims 1-49, 51-52, 54-56, and 64-72 are cancelled without prejudice for filing in a continuation application. Claims 50, 53, and 57-63 are pending.

II. Rejection of Claims 50, 53 and 57-63 under 35 U.S.C. §112, First Paragraph

Office Action

The Action states a rejection of Claims 50, 53 and 57-63 under 35 U.S.C. §112, first paragraph, for lacking description of “at least about 55%,” thereby adding new matter. The Examiner states that the specification only discloses “about 55%” in Example 7, or “55%” in Examples 1, 3, 6 and 8 for the ethanol concentration used for eluting small RNA in the method. See Office Action at pages 2-4.

Response

Applicant respectfully traverses this rejection.

Applicant submits that the Examiner’s statement that the specification only discloses “about 55%” in Example 7, or “55%” in Examples 1, 3, 6 and 8 for the ethanol concentration used for eluting small RNA in the method demonstrates a misunderstanding of the claimed method regarding binding conditions and elution conditions for the following reasons. (Emphasis added).

Applicant respectfully points out that the lysate/alcohol mixture of “at least about 55%” that results from f) of Claim 50 is then applied to a second solid support wherein small RNA molecules bind to the second solid support as recited in g) of Claim 50. Subsequent to that binding, small RNA molecules are eluted from the second solid support as recited in h) of Claim 50.

As evidence that binding takes place in “at least about 55%” ethanol, kindly review FIG. 1 and FIG. 2 where concentrations of ethanol of 55%, 60%, 65%, and 70% ethanol were demonstrated to provide binding of let-7 miRNA. As stated in the Office Action at page 3, third full paragraph, “at least about 55%” is considered as “about 55% and more,” which is clearly supported by the data and by the specification as cited.

Eluting small RNA molecules from the second solid support as recited by h) of Claim 50 occurs using any elution solution as provided for by the specification at page 10, for example, lines 21-27, and by the examples.

Therefore, the cited rejection indicates that the Examiner has misunderstood the method as claimed.

Further, to require that the phrase "at least about 55%" be limited as suggested by the Examiner would force Applicant to accept claims narrower than his invention in order to secure allowance of his patent. See, e.g., *Application of Sus*, 49 CCPA 1301, 306 F.2d 494, 134 USPQ 301,304 (1962):

The public purpose on which the patent law rests requires the granting of claims commensurate in scope with the invention disclosed. This requires as much the granting of broad claims on broad inventions as it does granting of specific claims on more specific inventions. It is neither contemplated by the public purpose of the patent laws nor required by the statute that an inventor shall be forced to accept claims narrower than his invention in order to secure allowance of his patent. *Application of Sus*, 49 CCPA 1301, 306 F.2d 494, 134 USPQ 301,304 (1962).

Applicant submits that the phrase "at least about 55%" has written description support in the specification as originally filed and does not provide new matter for the reasons cited above. In light of the remarks herein, Applicant respectfully requests withdrawal of the rejection of Claims 50, 53 and 57-63 under Section 112, first paragraph.

III. Supplemental Information Disclosure Statement

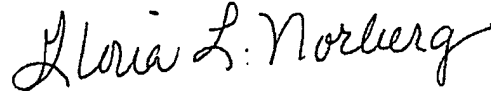
Applicant submits herewith a Supplemental Information Disclosure Statement listing, *inter alia*, Office Actions of foreign patent applications related to the instant application. Applicants respectfully request that the references cited therein be made of record and a copy of the marked-up PTO-1449 form signed/initialed by the Examiner be forwarded to Applicants.

IV. Conclusion

Applicant believes that the present document is a full and complete response to the Action dated October 28, 2008. Applicant believes that the application is in condition for allowance and respectfully requests issuance of a Notice of Allowance. If the Examiner does not

consider the application to be in condition for allowance, Applicant requests that he/she call the undersigned at (512)721.3654 to set up an interview.

Respectfully submitted,



Gloria L. Norberg
Reg. No. 36,706
Agent for Applicants

Applied Biosystems
2130 Woodward Street
Austin, Texas 78744
(512) 721-3654

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